

#### IV. REMARKS

1. Claims 1-5 and 7-15 remain in the application. Claim 6 has been cancelled.
2. Claim 9 has been amended to correct a typographical error.
3. The Abstract of the Disclosure has been amended to comply with MPEP 608.01(b). A replacement Abstract of the Disclosure is provided on a separate sheet attached hereto.
4. Claims 1 and 6 were rejected under 35 USC 112, second paragraph. Claim 1 has been amended to overcome any indefiniteness and claim 6 has been cancelled.
5. Claims 1-5 and 7-15 are patentable over Miller et al. (WO 98/47112, "Miller").

Miller fails to disclose or suggest a method, system, or computer program product, for prepayment of a service as recited by claims 1, 14, and 15. In particular, Miller also fails to disclose or suggest the following features of claims 1, 11, 14, and 15:

informing the user of the availability of a plurality of different services;

receiving from the user an authentication key to indicate prepayment for the requested service and verifying the validity of the authentication key.

Miller discloses a method, network device and network for electronically vending pre-paid values such as cellular air time. The method is associated with user specific prepaid

accounts stored in association with subscriber data. The prepaid accounts store prepaid value for a given subscriber. A prepaid account is decreased during each call made by the subscriber. Calling is prevented when the prepaid account has been consumed.

Miller discloses a network device i.e. kiosk connected to a network by which value can be added to the prepaid account of a given subscriber. In the method disclosed by Miller the lump values to be added to an account are identified using PINs. A subscriber purchases prepaid values using a network device to which may be associated a cash deposition unit or a magnetic card reader. The purchase occurs by paying a specified value at the network device. Magnetic cards are authenticated using a PIN associated with them in the same manner as in standard Automatic Teller Machines (ATM). The network device informs a network switch of the purchase transaction. The network switch sends a debiting request to the subscriber's bank. The bank debits the subscriber's account or registers the cash deposited. After the bank has acknowledged the network switch allocates a PIN and informs it to the subscriber. Thereafter, the subscriber is able to activate the prepaid value associated with the PIN by calling a service number and entering the PIN. At that time the prepaid value is added to the subscribers prepaid account.

5.1 Firstly, the method disclosed by Miller is not related to "a method for prepayment of a service" as recited in claims 1, 14 and 15 in the present application. Miller discloses a method for debiting a user's prepaid account, not for using it in the payment of services. Miller fails to disclose how the prepaid

account is actually further utilised as services are to be purchased using a prepaid account.

5.2 Secondly, Miller fails to disclose or suggest "informing the user of the availability of a plurality of different services." The Office Action states that this feature is disclosed in association with the description of Miller's Figure 1. However, a careful reading of Miller finds that Miller only discloses a user interface for the prepaid purchase and has no disclosure related to informing a user of a plurality of different services. For example, page 14 lines 3-6 of Miller states: "selecting the correct option on the interface menu of the network device starts the process (of prepaid value purchase)". However, there is no indication of informing a user of a plurality of different services. One reasonably skilled in the art would not interpret a user interface for a prepaid purchase as disclosing the idea of informing the user of the availability of a plurality of different services. When prepaid value is purchased, there is no plurality of different services, but instead options pertaining to one service, that is, the prepaid service.

5.3 Thirdly, Miller fails to disclose or suggest the feature of "receiving from the user an authentication key to indicate prepayment for the requested service and verifying whether the authentication key is valid." In this feature, receiving an authentication key from the user indicates that the user is willing to pay for the service using prepayment, whereas in Miller verifying a PIN code associated with a magnetic card merely indicates that the user is the rightful owner of the magnetic card. In any case in Miller the PIN code verifying

merely proves the capability of the user i.e. the cardholder to pay.

The authentication key in the present invention is distinguished from a bank card or a pre-registered banking relationship because the present specification clearly states on page 9, lines 21-23 that the "authentication keys are certificates that prove prepayment of a service." A bank card or a pre-registered banking relationship may suggest the ability to pay, but does not suggest a prepayment.

Claim 2-5 and 7-13 depend on claim 1 and therefore are also patentable over Miller.

6. Claim 2 is patentable over the combination of Miller in view of Mueller et al. (US 6,222,915, "Mueller").

Claim 2 depends from claim 1. Mueller fails to provide the features of claim 1 missing from Miller and therefore, the combination of Miller and Mueller fails to render claim 2 unpatentable.

Furthermore, in column 1, line 66 through column 2, line 6, cited in the Office Action, Mueller discloses that the aim of a calling card system is to provide all components which the user needs to fulfill his service request. In other words, a user will make a service request and that the system aims to provide all components to fulfill the request. There is no disclosure in either reference related to informing the user of a plurality of different services, and no disclosure related to informing the user of the availability of a plurality of different contents.

The Office Action states that Mueller's aim to offer all components that satisfy the request would require basic information about each service to be provided to the user. Applicants respectfully disagree that such a request would require such information and that informing the user of a plurality of different services, and informing the user of the availability of a plurality of different contents are not inherent in Miller or Mueller.

Applicants wish to point out that a rejection based on inherency must include a rationale or evidence tending to show inherency.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency. ... To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.... (MPEP 2112 quoting *In re Rijckaert*, 9 F.3d 1531, 1534, (Fed. Cir. 1993), and *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App.&Inter. 1990), emphasis in originals).

Applicants respectfully submit that because these features are not necessarily part of Miller or Mueller, that the features of claim 2 are not inherent in Miller or Mueller.

At least for these reasons, the combination of Miller and Mueller fails to disclose or suggest all the features of claim 2 and thus fails to render claim 2 unpatentable.

7. Claims 4 and 7 are patentable over the combination of Miller in view of Geiger et al. (US 6,377,810, "Geiger").

Claims 4 and 7 depend from claim 1. Geiger fails to provide the features of claim 1 missing from Miller and therefore, the combination of Miller and Geiger fails to render claims 4 and 7 unpatentable.

Furthermore, with regard to claim 7, the Office Action correctly points out that Miller fails to disclose or suggest scanning the data base of used authentication keys for detecting lapsed authentication keys for removing them from the data base of used authentication keys. The Office Action goes on to state that one skilled in the art would provide for tracking of the keys for validity/expiration and that it would have been obvious to one skilled in the art to modify Miller to provide means for tracking keys and removing those that are expired. A careful reading of Geiger finds no disclosure related to this feature, that is, no disclosure related to scanning the data base of used authentication keys for detecting lapsed authentication keys, and no disclosure related to removing them from the data base of used authentication keys.

Applicant also notes that such a feature is clearly not inherent in Miller or Geiger using the test for inherency mentioned above.

At least for these reasons, the combination of Miller and Geiger fails to disclose all the features of claim 4 and 7 and fails to render claims 4 and 7 unpatentable.

8. Claims 5 and 8 are patentable over the combination of Miller in view of Lesley (US 6,188,752).

Claims 5 and 8 depend from claim 1. Lesley fails to provide the features of claim 1 missing from Miller and therefore, the

combination of Miller and Lesley fails to render claims 5 and 8 unpatentable.

9. Claim 11 is patentable over the combination of Miller in view of Carlsson et al. (US 6,490,367, "Carlsson").

Claim 11 depends from claim 1. Carlsson fails to provide the features of claim 1 missing from Miller and therefore, the combination of Miller and Carlsson fails to render claim 11 unpatentable.

10. Claim 13 is patentable over the combination of Miller in view of Comer (US 5,610,973).

Claim 13 depends from claim 1. Comer fails to provide the features of claim 1 missing from Miller and therefore, the combination of Miller and Comer fails to render claim 13 unpatentable.


Furthermore, the Office Action correctly points out that Miller fails to disclose allowing the user to test a service requested and receiving a final verification from the user before the user is provided with the service. Comer also fails to disclose or suggest this feature.

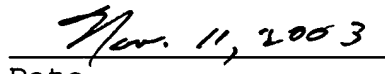
Comer discloses a system that identifies roaming users and solicits them to utilize services. A careful reading Comer finds no disclosure or suggestion related to allowing a user to test a service and no disclosure or suggestion of receiving a final verification from the user before the user is provided with the service. At least for these reasons, Applicant submits that claim 13 is patentable over the combination of Miller and Comer.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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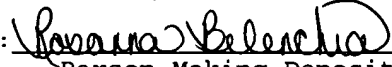
  
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